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## 1412.02 Recapture of Canceled Subject Matter [R-7] - 1400 Correction of Patents

**1412.02 Recapture of Canceled Subject Matter [R-7]**

A Reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005); *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 288, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

**I. THREE STEP TEST FOR RECAPTURE:**

In *Clement*, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. In *North American Container*, 415 F.3d at 1349, 75 USPQ2d at 1556, the court restated this test as follows:

We apply the recapture rule as a three-step process:

- (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;
- (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and
- (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

In *North American Container*, the court cited *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600; *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; and *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164-65 as cases that lead to, and explain the language in, the *North American Container* recapture test.<sup>4</sup>

### A. The First Step - Was There Broadening?

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance as to the nature of a "broadening claim." If the reissue claim is not broadened in any respect as

compared to the patent claims, the analysis ends; there is no recapture.

## **B. The Second Step - Does Any Broadening Aspect of the Reissued Claim Relate to Surrendered Subject Matter?**

Where a claim in a reissue application is broadened in some respect as compared to the patent claims, the examiner must next determine whether the broadening aspect(s) of that reissue claim relate(s) to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination. This involves two sub-steps:

### **1. The Two Sub-Steps:**

(A) \*\*>One must first determine whether applicant surrendered any< subject matter \* in the prosecution of the original application >that< became the patent to be reissued. If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by \*\* presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art. To determine whether such reliance occurred, the examiner must review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein. If \*\*>applicant did not< surrender \*any< subject matter \* in the prosecution of the original application, again the analysis ends and there is no recapture.

(B) If \*\*>applicant did< surrender \* subject matter in the original application prosecution, >the examiner< must then \*\*>determine< whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. >The examiner must analyze all< of the broadening aspects of reissue claims \*\* to determine if any of the omitted/broadened limitation(s) are directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.

### **2. Examples of the \*Second Step Analysis:**

(A) Example (1) - Argument without amendment:

In *Hester, supra*, the Federal Circuit held that the surrender >that< forms the basis for impermissible recapture "can occur through arguments alone". 142 F.3d at 1482, 46 USPQ2d at 1649. For example, assume that limitation A of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. If the omitted limitation A was argued in the original application to make the application claims allowable over the art in the application, then the omitted limitation relates to subject matter previously surrendered in the original application, and recapture will exist. Accordingly, where claims are broadened in a reissue application, the examiner should review the prosecution history of the original patent file for recapture, even where the claims were never amended during the prosecution of the application which resulted in the patent.

Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation relied upon, rather than a general statement regarding the claims as a whole. A general "boiler plate" sentence in the original application will not, by itself, be sufficient to establish surrender and recapture.

An example of a general "boiler plate" sentence of argument is:

In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable.

An argument that merely states that all the limitations of the claims define over the prior art will also not, by itself, be sufficient to establish surrender and recapture. An example is:

Claims 1-5 set forth a power-train apparatus which comprises the combination of A+B+C+D+E. The prior art of record does not disclose or \*\*>otherwise teach, providing< a material-transfer apparatus as defined by the limitations of claim 1, including an A member and a B member, both connected to a C member, with all three being aligned with the D and E members.

This statement is simply a restatement of the entirety of claim 1 as allowed. No measure of surrender could be gleaned from such a statement of reasons for allowance. See *Ex parte Yamaguchi*, 61 USPQ2d 1043

(Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential).

In both of the above examples, the argument does not provide an indication of what specific limitations, e.g., specific element or step of the claims, cooperative effect, or other aspect of the claims, are being relied upon for patentability. Thus, applicant has not surrendered anything.

(B) Example (2) - Amendment of the claims without argument:

The limitation omitted in the reissue claim(s) was added in the original application claims for the purpose of making the application claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. To illustrate this, note the following example:

The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter. Accordingly, the reissued claims would be barred by the recapture doctrine.

The above result would be the same whether the addition of limitation D in the original application was by way of applicant's amendment or by way of an examiner's amendment with authorization by applicant.

(C) Example (3) - Who can make the surrendering argument?

Assume that the limitation A omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue.

*Ex parte Yamaguchi*, supra, held that a surrender of claimed subject matter cannot be based solely upon an applicant's failure to respond to, or failure to challenge, an examiner's statement made during the prosecution of an application. Applicant is bound only by applicant's revision of the application claims or a positive argument/statement by applicant. An applicant's failure to present on the record a counter statement or comment as to an examiner's reasons for allowance does not give rise to any implication that applicant agreed with or acquiesced in the examiner's reasoning for allowance. Thus, the failure to present a counter statement or comment as to the examiner's statement of reasons for allowance does not give rise to any finding of surrender. **The examiner's statement of reasons for allowance in the original application cannot, by itself, provide the basis for establishing surrender and recapture.**

It is only in the situation where applicant does file comments on the statement of reasons for allowance, that surrender may have occurred. Note the following two scenarios in which an applicant files comments:

**Scenario 1 - There is Surrender:** The examiner's statement of reasons for allowance in the original application stated that it was limitation C (of the combination of ABC) which distinguished over a potential combining of references X and Y, in that limitation C provided increased speed to the process. Applicant filed comments on the examiner's statement of reasons for allowance essentially supporting the examiner's reasons. The limitation C is thus established as relating to subject matter previously surrendered.

**Scenario 2 - There is No Surrender:** On the other hand, if applicant's comments on the examiner's statement of reasons for allowance contain a counter statement that it is limitation B (of the combination of ABC), rather than C, which distinguishes the claims over the art, then limitation B would constitute surrendered subject matter, and limitation C has not been surrendered.

**C. The Third Step - Were the reissued claims materially narrowed in other respects \*\*\*, so that the claims may not have been enlarged, and hence avoid the recapture rule?**

As pointed out above, the third prong of the recapture determination set forth in \*North American Container\* is directed to analysis of the broadening and narrowing effected \*\*by< the reissue claims, and of the significance of the claim limitations added and deleted, using the prosecution history of the patent (to be

reissued), to determine whether the reissue claims should be barred as recapture.

The following discussion addresses analyzing the reissue claims, and *which* claims are to be compared to the reissue claims in determining the issue of surrender (for reissue recapture).

When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. If the reissue claim "fails" either analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the claim. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement, supra*.

Second, it must be determined whether the reissue claim "omits >or broadens<" any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu* \*\*, 258 F.3d at 1371-72, 59 USPQ2d at 1600. In any broadening reissue application, the examiner will determine, on a claim-by-claim basis, whether the broadening in the reissue application relates to subject matter that was surrendered during the examination of the patent that is the subject of the reissue application because such subject matter was added and/or argued to overcome a rejection. If surrendered subject matter has been entirely eliminated from a claim in the reissue application, or has been in any way broadened in a reissue application claim, then a recapture rejection under 35 U.S.C. 251 is proper and must be made for that claim.

If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present. Note the following examples:

Assume that, in the original prosecution of the patent, applicant claimed a method of making a glass lens, where the ion implantation step used a molten bath to diffuse ions into the lens, and that step had to be amended to recite a pressure of 50-60 PSI and temperature between 150-200 degrees C - to define over the art. That pressure and temperature range-set is "frozen" in place for any molten bath ion implantation claim, and it cannot be deleted or broadened by reissue. However, if in the original application, applicant had failed to claim a disclosed embodiment to plasma ion implantation (i.e., using a plasma stream rather than a molten bath to provide the ions), that is a proper 35 U.S.C. 251 error, which can be corrected by reissue. Applicant can, in a reissue application, add a set of claims to plasma ion implantation, without including the "50-60 PSI and temperature between 150-200 degrees C" limitation. The "50-60 PSI - 150-200 degrees C limitation" is totally irrelevant to plasma implantation and is clearly wrong for the plasma species/embodiment, as opposed to being right for the molten bath species/embodiment. Also, if in the original application, applicant failed to claim the method of placing two lenses made by the invention in a specified series to modulate a laser for cutting chocolate, that too is a proper 35 U.S.C. 251 error, which can be corrected by reissue. In this lens placement method, it does not matter how the specific lens having the implanted ion gradient was made, and the "50-60 PSI and temperature between 150-200 degrees C" limitation is again not relevant. *Hester Industries, Inc. v. Stein, Inc., supra*, addressed this concept of overlooked aspects, stating:

[T]his principle [i.e., avoidance of the recapture rule], in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other **overlooked aspects** of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects. [*Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50.] [Emphasis added]

See also *B.E. Meyers & Co. v. United States*, 56 USPQ2d 1110 (US CtFedCis 2000), where the Court of Federal Claims permitted the complete removal of a limitation that was added to obtain the patent, where the replacement limitation provided a separate invention.<

The following discussion is provided for analyzing the reissue claims.

# **1. \*\*>Comparing< Reissue Claims Narrowed/Broadened Vis-à-vis the Canceled Claims**

\*>DEFINITIONS<:

"Canceled claims," in the context of recapture case law, are claims canceled from the original application to obtain the patent for which reissue is now being sought. The claims

(A) can simply be canceled and not replaced by others, or

(B) can be canceled and replaced by other claims which are more specific than the canceled claims in at least one aspect (to thereby define over the art of record). The "replacement claims" can be new claims which are narrower than the canceled claims, or can be the same claims amended to be narrower than the canceled version of the claims.

>"Surrender-generating limitation" - The "limitation" presented, argued, or stated to make the claims patentable over the art (in the application) "generates" the surrender of claimed subject matter. For the sake of simplification, this limitation will be referred to throughout this section as the *surrender-generating limitation*.<

**(a) Reissue Claims Are Same or Broader in Scope Than Canceled Claims in All Aspects:**

The recapture rule bars the patentee from acquiring, through reissue, claims that are in all aspects (A) of the same scope as, or (B) broader in scope than, those claims canceled from the original application to obtain a patent. *\*\* Ball Corp. v. United States*, 729 F.2d at 1436, 221 USPQ at 295.

**(b) Reissue Claims are Narrower in Scope Than Canceled Claims in at Least One Aspect:**

If the reissue claims are equal in scope to, or narrower than, the claims of the original patent (as opposed to the claims "canceled from the application") in all aspects, then there can never be recapture. The discussion that follows is not directed to that situation. It is rather directed to the situation where the *reissue claims are narrower than the claims "canceled" from the application in some aspect, but are broader than the claims of the original patent in some other aspect*.

If the reissue claims are narrower in scope than the claims canceled from the original application by inclusion of the >entirety of the< *limitation added to define the original application claims over the art*, there will be no recapture, even if the reissue claims are broader than the canceled claims in some other aspect (i.e., an aspect not related to the surrender made in the original application).

Assume combination AB was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABC (after which the patent issued). The reissue claims are then directed to combination AB

broadened

C. The AB

broadened

C claims are *narrower* in scope when compared with the canceled claim subject matter AB *in respect to the addition of C* (which was added in the application to overcome the art), and >they retain surrender-generating limitation C; thus,< there is no recapture.

As another example, assume combination ABZ was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABZC (after which the patent issued). The reissue claims are then directed to combination ABC (i.e., element Z is deleted from the canceled claims, while element C remains present). The ABC claims of the reissue are *narrower* in scope as compared to the canceled-from-the-original-application claim subject matter ABZ *in respect to the addition of C* (which was added in the application to overcome the art), and >they retain surrender-generating limitation C; thus, there is< no recapture.

**2. *\*\*>Comparing< Reissue Claims Narrowed/Broadened >Vis<-à-vis the Patent Claims***

The "patent claims," in the context of recapture case law, are claims ">that< issued in the original patent for which reissue is now being sought. As pointed out above, where the reissue claims are narrower than the claims of the original patent in all aspects, then there can never be recapture. If reissue claims are equal in scope to the patent claims, there is no recapture as to those reissue claims. Where, however, reissue claims are both broadened and narrowed as compared with the original patent claims, the nature of the broadening and narrowing must be examined to determine whether the reissue claims are barred as being recapture of surrendered subject matter. If the claims are "broader than they are narrower in a manner directly pertinent to the subject matter... surrendered during prosecution" (*Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166),

then recapture will bar the claims. This narrowing/broadening *vis-à-vis* the patent is broken down into four possibilities that will now be addressed.

\*\* If a claim is presented in a reissue application that omits, in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 U.S.C. 251. This terminology will be used in the discussion of the four categories of narrowing/broadening *vis-à-vis* the **patent** that follows.

**(a) Reissue Claims are Narrower in Scope Than Patent Claims, in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope by Omitting Limitation(s) Added/Argued To Overcome Art Rejection in Original Prosecution:**

In this case, there is recapture.

This situation is where the patent claims are directed to combination ABC and the reissue claims are directed to ABD. Element C was either a limitation added to AB to obtain allowance of the original patent, or was argued by applicant to define over the art (or both). Thus, addition of C (and/or argument as to C) has resulted in the surrender of any combination of A & B that does not include C; this is the surrendered subject matter. Element D, on the other hand, is not related to the surrendered subject matter. Thus, the reissue claim, which no longer contains C, is broadened in an area related to the surrender, and the narrowing ">by< the addition of D does not save the claim from recapture ">because< D is not related to the surrendered subject matter.

Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation (element C, in the example given) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

**(b) Reissue Claims are Narrower or Equal in Scope, in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope in Area Not Directed to Amendment/Argument:**

In this case, there is no recapture.

This situation is where the patent claims are directed to combination ABCDE and the reissue claims are directed to ABDE (element C is omitted). Assume that the combination of ABCD was present in the original application as it was filed, and element E was later added to define over that art. No argument was ever presented as to elements A-C defining over the art.

In this situation, the ABCDE combination of the patent can be broadened (in the reissue application) to omit element C, and thereby claim the combination of ABDE, where element E (the surrender generating limitation) is not omitted. There would be no recapture in this instance. (If an argument had been presented as to element C defining over the art, in addition to the addition of element E, then the ABCDE combination could not be broadened to omit element C and thereby claim combination of ABDE. This would be recapture; see the above discussion as to surrender and recapture based upon argument.)

Additionally, the reissue claims are certainly permitted to recite combination ABDE

specific

(where surrender-generating element E is narrowed). The patent claims have been broadened in an area not directed to the surrender (by omitting element C) and narrowed in the area of surrender (by narrowing element E to E

specific

). This is clearly permitted.

As another example, assume limitation C was added to application claims AB to obtain the patent to ABC, and now the reissue application presents claims to AC or AB

broad

C. Such reissue claims avoid the effect of the recapture rule because they are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). Such claims are considered to be broader in an aspect not "germane to a prior art rejection," and thus are not barred by recapture. Note *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

Reissue claims that are broader than the original patent claims by deletion of a limitation or claim requirement other than the "surrender-generating limitation" will avoid the effect of the recapture rule, regardless of the nature of the narrowing in the claims, and even if the claims are not narrowed at all from the scope of the patent claims.

**(c) Reissue Claims are Narrower in Scope in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope in Area Not Directed to the Amendment/Argument:**

In this instance, there is clearly no recapture. In the reissue application, there has been no change in the claims related to the matter surrendered in the original application for the patent.

In this instance, element C was added to the AB combination to provide ABC and define over the art, and the patent was issued. The reissue omits element B and adds element Z, to thus claim ACZ. There is no recapture ">because< the surrender generating element C has not been modified in any way. (Note, however, that if, when element C was added to AB, applicant argued that the association of newly added C with B provides a synergistic (unexpected) result to thus define over the art, then neither >element< B nor >element< C could be omitted in the reissue application.)

**(d) Reissue Claims Broader in Scope in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; but Reissue Claims Retain, in Broadened Form, the Limitation(s) Argued/Added to Overcome Art Rejection in Original Prosecution:**

>In this case, there is recapture.<

Assume the combination AB was originally claimed in the application, and was amended in reply to an art rejection to add element C and thus provide the combination ABC (after which the patent issued). A reissue application is then filed, and the reissue application claims are directed to the combination ABCbroadened. The ABCbroadened claims are narrowed in scope when compared with the canceled claim subject matter AB, because of the addition of Cbroadened. Thus, the claims retain, in broadened form, the limitation argued/added to overcome art rejection in original prosecution. ">In this instance, a recapture rejection would be made even though< ABCbroadened is narrower than canceled claim subject matter AB >, because the surrender-generating limitation C has been broadened, i.e., there is broadening< in an area related to the surrender. "

**II. REISSUE TO TAKE ADVANTAGE OF 35 U.S.C. 103(b):**

A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). **This is not to be considered a recapture.** The addition of process claims, however, will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

**III. REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:**

A patentee may file a reissue application to permit consideration of article of manufacture claims >(not presented in the patent to be reissued)< which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

#### IV. REJECTION BASED UPON RECAPTURE:

Reissue claims which recapture surrendered subject matter should be rejected using form paragraph 14.17.

##### ¶ 14.17 Rejection, 35 U.S.C. 251, Recapture

Claim[1] rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

[2]

##### Examiner Note:

In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the "broadening aspect" to the claim(s), and where in the original application the narrowed claim scope was presented/argued to obviate a rejection/objecton. See MPEP § 1412.02.

>

#### V. REBUTTAL BY THE REISSUE APPLICANT

The reissue applicant may rebut a recapture rejection by demonstrating that a claim rejected for recapture includes one or more claim limitations that "materially narrow" the reissue claims. A limitation is said to "materially narrow" the reissue claims if the narrowing limitation is directed to one or more "overlooked aspects" of the invention. *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50. The inclusion of such a limitation in a claim rejected for recapture will overcome the recapture rejection. A limitation that had been prosecuted in the original patent application is not directed to "overlooked aspects" of the disclosed invention and will not overcome the recapture rejection.

Examples of reissue application claims that are to be rejected for recapture under 35 U.S.C. 251 include:

Assume that the original application claim ABCD was amended during prosecution and results in a patent claim ABCDE.

1. ABCD → Eliminates E, the surrender generating limitation (SGL).
2. ABCDF → Eliminates E, the SGL, adds narrowing limitation F.
3. ABCDEBROADER → Broadens E, the SGL.
4. ABCDEBROADERF → Broadens E, the SGL, adds narrowing limitation F.

In these four examples, a recapture rejection would be made. Applicant may try to rebut the recapture rejections of examples 2 and 4 by showing that limitation F "materially narrows" the reissue claims, if F is directed to an "overlooked aspect" of the disclosed invention, as discussed above. The examiner will then determine whether F, or a limitation "similar to" F, had been prosecuted in the application for the original patent. If so, the recapture rejection will not be overcome. Of course, if the examiner is aware of the fact that F is directed to an "overlooked aspect" of the disclosed invention as discussed above, the examiner would so explain in the next Office action, and would then not make the recapture rejection in the first place.

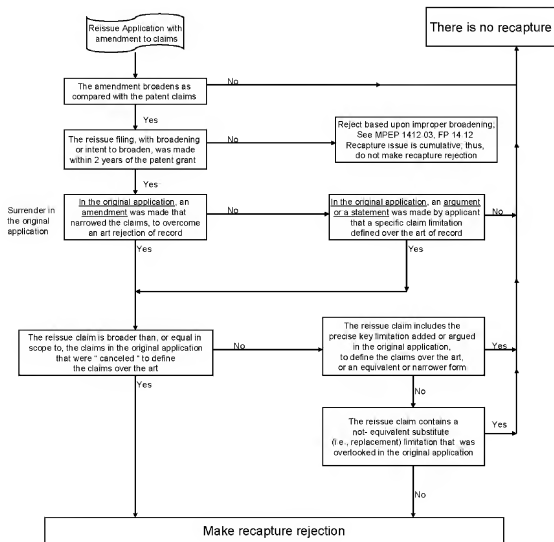
#### VI. FLOWCHART<

See the recapture-analysis flow chart which follows for assistance in determining whether recapture is present, consistent with the case law discussed above.



&gt;

## Reissue Recapture - Determining its presence or absence



&lt;

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KEY: =online business system =fees =forms =help =laws/regulations =definition (glossary)

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